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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,788	02/12/2001	Larry Wolf	72890/10396	6968

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EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/781,788

Applicant(s)

WOLF ET AL.

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213. .

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 16-29 is/are pending in the application.
- 4a) Of the above claim(s) 16-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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Response To Applicant's Arguments

The Examiner herein approves the new and replacement drawings and the changes to the specification. Further, the French Doc. is not considered once again because the Examiner did not receive the translated abstract.

DETAILED ACTION

Claim Status

Claims 1-11 were elected, without traverse, for prosecution on the merits after a restriction requirement and new claims 16-29 are herein being withdrawn from further consideration, by original presentation, for presenting an invention different from the original invention.

Indeed, independent claim 16 recites, among other things, a service provider for collecting and inputting the employees data of one or more employees of an employer into one employee database managed by the service provider (See the Action mailed on 11/17/2005 and MPEP 821.03).

General Comments

In claims 1 and 8, in “analyzing the employees data to categorize employees into one or more categories” implies analyzing the employees data, based on certain parameters, to better target the employees, wherein one or more employees receive one specific advertisement based on their profile (i.e. income, demographics). In other words, “categorize employees into one or more categories” is just a nominal recitation since there no specific segmentation per se

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associated with the categories. In general, categorizing, segmenting, grouping or classifying involves forming one or more groups or categories or classes based on some specific criteria.

The claims never recite grouping or clustering the employees based on specific criteria.

In claims 2 and 3, in printing the targeted advertisements on either the front portion, side portion or the back or reverse portion of the payslips or paycheck stubs from either direct deposits or issued physical checks, the Examiner notes that where the advertisements are printed on the payslips or paycheck stubs from either direct deposits or physical checks does not affect the functionality of the system, which is operable to print targeted advertisements on the payslips or paycheck stubs of the employees.

Claim Objections

Claim 8 is objected to because of the following informalities-

Regarding claim 8, "one or more advertisement" should apparently be --one or more advertisements--.

Appropriate corrections are necessary.

Claim Rejections - 35 USC § 102



The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Oldfield in article, Payslip Advertisements, Times of London -11/16/97.

Regarding claims 1-6 and 8, Oldfield describes the concept of business B (an advertiser) paying business A (an employer) to have one or more advertisements for products/services of business B printed onto payslips or paycheck stubs (in the front, the side, on the reverse or back of direct or non-direct deposit payslips or paycheck stubs) of business A's employees. Indeed, Payroll Marketing is disclosed for introducing wages departments to a rich source of **revenue and advertisers to a captive audience**. More payslips or paycheck stubs pass through Samantha Yates's (payroll manager) hands in a year than most people are likely to see in a lifetime - about 33m (33 millions) in fact. The Payroll Marketing concept is simple: Yates acts like a marriage broker, **ensuring that an advertiser is matched with the appropriate firm to reach a specific market by advertising on payslips (printing targeted advertisements on employees' payslips or paycheck stubs)**. She then follows up with negotiations between the two parties.

Further, Yates and Simon Little, her husband and fellow director, earn commission for arranging the advertising service; the advertisers benefit through the number of people they reach and gain an implied employer endorsement; and the payslip issuer benefits through a guaranteed annual income.

Yates says: **"It is a very targeted form of advertising, wherein advertisers know that they are reaching people who are in full employment, which is important if they are offering financial or credit services (receiving and analyzing employees' data to form one or more groups or categories of employees or to decide which one or more employees**

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should receive a specific advertisement from an advertiser based on their profile or employees' data kept or made available by the employers since the employees do not directly provide the employees' data including demographic data (such as age, income or salary, sex, marital status, education, number of children if any, etc.) to the advertisers or a third party).

"The employer is satisfied because employees get extra benefits. For instance, we would get special arrangements such as a lower rate of interest or shop discount for those people the advertiser reaches." Already staff or employees have been offered discounts on mobile phones, furniture and weekend breaks (based on the employees' profile or interest or psychographic data) and this area of the service is likely to grow. Advertisers, such as Barclays and Churchill Insurance, are keen to take advantage **of Payroll Marketing's service because it is cheaper than direct mailing and generates a greater response rate.**

It is four years since Yates and Little spotted an opportunity to exploit the space on pay slips or paycheck stubs and decided to leave their jobs (Yates as a designer and copywriter and Little as a financial adviser) to set up Payroll Marketing (printing one or more advertisements from an advertiser on employees' paycheck stubs based on a match between the employees' data and the advertiser 's criteria). Initially, Yates and Little concentrated on local councils, where payrolls were tightly controlled (to gain access to the employees' data). They were quick off the mark, offering a comparatively cheap service in an area that was virgin territory.

There are now several firms offering similar services, but Yates says that there is no serious competitor. "If another agency came in like us it would be good because it would help

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establish codes of practice. At the moment, cowboys are making the fight harder." **Yates and Little are determined to stick with payslips** rather than move into other areas. They have been offered the chance to arrange advertising on pizza boxes and parking tickets, but have so far resisted the temptation. Instead they are keen to explore new payrolls and bring in new advertisers. Yates aims to expand over the next couple of years and to add to the current staff of 10. "We've appointed a sales team," she says. "And we have been offered a lot of new media that are aimed at an AB market as well as payrolls such as Lancashire county council, Birmingham city council and Vision Express."

It is herein understood that the employees' data provided by the employers for the purpose of printing targeted advertisements on the employees' payslips or paycheck stubs may not contain the employees' private or confidential information (such as disciplinary actions taken against an employee, medical condition or history of an employee, etc.).

Please consider the whole article.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 10, 11 and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Oldfield in article, Payslip Advertisements, Times of London -11/16/97.

As per claims 7 and 9-10, Oldfield does not specifically teach or suggest a system wherein advertisers bid for the privilege to have their advertisements printed on employees payslips or paycheck stubs by submitting their bids via (to) a secure sever, nor does she teach using a secure server (web server) having a database to receive the employees data associated with or more employees (or to receive employees data from a group of employees and to store the received data in a secure server database).

First of all, it is customary in the art of advertising distribution to have advertisers participate in an open bid by competing for the right or privilege to present or display their advertising messages to specific prospects or customers (no further disclosure is necessary here).

Second of all, it is common practice for businesses and organizations to use a secure file server to store data including employees data to thereby protect the information such that only authorized users with proper rights can have limited/unlimited access to the stored data based on those rights (this is well documented under network security). For instance, an organization, such as PTO, receives employees data from the employees via a paper application or an online application (electronic form), wherein the original data received from the employees are permanent stored in one or more secure server databases and wherein the employees can update their data or profile in the future as need be or as their situation, such as marital status, changes. (No additional information is required here).

Finally, it is well established in the art to submit, over a network, important information or confidential information, such as a credit card information, to a secure server or to use a

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secure system, such as a secure terminal, to send important information to another secure system or server.

“Official Notice”

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure into the Oldfield's Payroll Marketing system so as receive and store the employees data in a secure server database, have advertisers bid or compete for the right to have their advertisements printed on the payslips or paycheck stubs of specific employees by submitting their bids via a secure sever, thereby rendering the advertising distribution system or the Payroll Marketing system more competitive and profitable by having advertisers submit real-time bids to a secure server for the privilege to have their targeted advertising messages printed on the employees payslips or paycheck stubs, while the intermediary (owner of the Payroll Marketing system) and the employers are able to increase their bottom line when advertisers bid by offer more money for an impression that they would not normally pay for the right to make such impression or to present an advertisement to an employee, as would have understood one of ordinary skill in the art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 6,285,987 to Roth discloses a system for providing advertisements from a central server to viewers who access web sites. The central server stores both advertisements, which are

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to be displayed, and an information database. The database includes information about viewers, information about the characteristics of particular web sites and other information relevant to which advertisements should be displayed for particular viewers. Proposed bids submitted by different advertisers are evaluated in real time in order to determine which particular advertisement will be displayed to a viewer. Each proposed bid can specify a price or amount that the advertiser is willing to pay for the opportunity to display an advertisement (a) to a viewer who has a particular set of characteristics and (b) on a web site and web page that meets a particular set of criteria. The system includes (a) a web server system which has data bases stored therein, (b) bidding agents which compare the characteristics of view-ops to the specifications in proposed bids and which submit bids as appropriate, and (c) bid selection logic which decides which bid to accept for each particular view-op.

USA Today (12/29/1989) teaches including in state worker's paychecks, ads soliciting newspaper subscriptions.

Smith (San Diego Business Journal 4/6/98) teaches printing messages on paycheck stubs, solicitations to vote on Proposition A.

Electronic Office (5/20/92) teaches income creation schemes such as carrying ads on the back of staff payslips.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner

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by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

JDJ

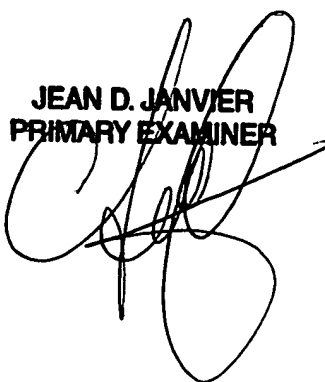
Jean D. Janvier

05/14/06

Patent Examiner

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JEAN D. JANVIER
PRIMARY EXAMINER

A handwritten signature in black ink, consisting of a large, stylized 'J' and 'D' followed by a horizontal line and a large loop.